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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,101	12/07/2000	Werner Sobek		8961

7590 06/05/2003

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EXAMINER

TRAN A, PHI DIEU N

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,101

Applicant(s)

SOBEK ET AL.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) 25-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/03 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ennis(5463788).

Ennis (figures 1-3) shows a device having a shank (52), a cap (20, 18) connected to the shank having a membrane having tensile strength and low flexural strength, a circular base surface(each layer of the membrane forming a circular base surface), driving means (54, 28) for driving said membrane, wherein said membrane defining a position of rest wherein it droops limply around said shank (figure 3) and an open position wherein it assumes an essentially horizontally position under the influence of centrifugal force generated due to the rotation of the membrane by the driving means, the driving means being an electric motor(54), said driving means being located at the head of the shank, the shank being fixed against relative rotation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ennis (5463788) in view of Belanger (5127123).

Ennis shows all the claimed limitations except for the means clamping the membrane to the shank being two fixed disks.

Belanger (figure 6) shows two fixed disks clamping a membrane (35) to a shank(122).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ennis to show the means clamping the membrane to the shank being two fixed disks because using two fixed disks to clamp the membrane to the shank would strongly secure the membrane to the shank as taught by Belanger.

Ennis as modified shows all the claimed limitations.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ennis (5463788).

Ennis shows all the claimed limitations except for the motor being pneumatic.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ennis to show the motor being pneumatic because pneumatic, electrical, hydraulic motors are well-known drive means for rotating a shaft.

Ennis as modified shows all the claimed limitations.

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6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ennis (5463788) in view of Fromme (36834410).

Ennis shows all the claimed limitations except for the energy supply for the driving means being received in said shank.

Fromme shows the energy supply for the driving means (24, 10) being received in the shank (14).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ennis to show the energy supply for the driving means being received in said shank because routing an energy source through a tubular member to a driving means is well known in the art as it would enable nice, neat wire routing with the additional benefit of no wire entanglement with other surrounding moving structures.

Ennis as modified shows all the claimed limitations.

Response to Arguments

7. Applicant's arguments filed 5/19/03 to claims 18-24 have been fully considered but they are not persuasive. As the argument is virtually the same as in the previous office action, the previous arguments are stated below with an additional clarification to the membrane added below and the response to the patentable weight of the preamble "umbrella device".

8. In response to applicant's argument that Ennis is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977

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F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference teaches a rotating membrane which opens by rotational force and drooping at rest. It thus addresses the particular problem of opening up a membrane which droops at rest. It thus can certainly be used as an umbrella device if desired.

In response to applicant's argument that Ennis does not show every claimed limitations, examiner respectfully disagreed. First of all, membrane which comprises of the sheets altogether has tensile strength, low flexural strength and a circular base surface as in figures 1 and 4. The membrane constitutes the umbrella-like cap. Secondly, the argument that "there is no continuous structure" to the brush is moot as "continuous structure" is not claimed.

With respect to applicant's argument that Ennis cannot be combined with Belanger as the "the replacement cartridges are rigged", examiner respectfully disagrees. Belanger teaches two fixed disks clamping a membrane. Thus, Belanger's teaching is sought after to teach the missing "two fixed disks clamping a membrane" in the Ennis reference. The combination is thus proper. The argument is moot.

With respect to applicant's argument that modifying Ennis with Fromme does not cure the deficiency in the Ennis vis-à-vis the claimed invention, examiner respectfully disagrees. Ennis as modified by Fromme shows the claimed structure. The combination satisfies the claimed invention. The argument is thus moot.

Also with respect to applicant argument about the "membrane", examiner respectfully points out that the " membrane comprises of the sheets altogether" as pointed out in the office action and in the previous final office action, and altogether, the membrane has a circular base with the membrane having tensile strength, and low flexural strength.

With respect to applicant's argument about the preamble "umbrella device", a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone, Kropa v. Robie, 187 F.2d at 152, 88 USPQ at 481 (CCPA 1951). The body of the claims as they are, can stand alone. Thus, a prior art which meets the body of the claims also meet the entire claims including the preamble. The references applied above meet the body of the claims; the claims thus are fully rejected.

Conclusion

9. This is a RCE of applicant's earlier Application No. 09/646101. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,

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event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Phi Dieu Tran A
June 1, 2003



LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

